

REMARKS

Reconsideration of the present application is respectfully requested. In this response, claims 1, 14, 23, 24 and 30 have been amended, and no claims have been added or canceled. No new matter has been added.

Status of Claims

Claims 14-19 stand rejected under 35 U.S.C. § 102(b) based on Ellipsus White Paper -- InfiniteMAP™ ("Ellipsus"). Claims 1, 5, 6, 9, 10 and 23-30 stand rejected under 35 U.S.C. § 103(a) based on Ellipsus. Claims 1-30 stand provisionally rejected for obviousness-type double patenting based on co-pending U.S. patent application no. 10/600,746.

Double-Patenting Rejection

The stated reason for the obviousness-type double patenting rejection is that, "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending application are broader versions of the currently pending claims and fair for the current claims could be used to reject them" (Final Office Action, page 12).

Applicants respectfully submit that the rejection is in error. First, the rejection is unclear, as stated, in that it is not clear what the Examiner means by "the current claims" or "them". Specifically, it is not clear whether "the current claims" refers to the pending claims in the present application or the pending claims in the co-pending application, or vice versa. Similar confusion is associated with the use of the pronoun

“them”. In the event this rejection is maintained, Applicants request that the Examiner state the rationale more clearly.

Second, a mere conclusory allegation that “the claims of the co-pending application are broader versions of the currently pending claims,” without such allegation being supported by specific references to the claim language, is insufficient to support a rejection. Here, the Examiner provides no support or explanation for the allegation that “the claims of the co-pending application are broader versions of the currently pending claims.” Consequently, a *prima facie* case of double patenting has not been established, and the rejection is improper for at least this reason.

Furthermore, Applicants disagree with the allegation. At least some claims in the co-pending application may indeed be broader than at least some claims in the present application; however, Applicants disagree that the claims in the co-pending application are merely broader “versions of” the claims in the present application. Notwithstanding that the claims in these two respective applications may have some similarities, that contention is not correct. Even a cursory reading of the respective claim sets will reveal significant limitations in the independent claims of the co-pending application that are not present in the independent claims of the present application (and vice versa, of course). Consequently, the claims in the co-pending application cannot be considered merely broader “versions of” the claims in the present application. Note that since a *prima facie* case of double patenting has not been established (due to the lack of factual support for the rejection, as noted above), Applicants have no obligation at this point to identify those different limitations in response to this rejection.

For the above reasons, the obviousness-type double patenting rejection is in error and should be withdrawn.

Prior Art Rejections

Applicants respectfully maintain all of their previously submitted arguments regarding the prior art rejections (pp. 3-7 of response filed on 2/21/2006, and pp. 12-16 of amendment filed on 9/30/05), all of which are incorporated by reference into this response.

The Advisory Action states, "Claim 1 then continues with a number of 'wherein clauses', which according to and MPEP 2111.04 do not limit claims cope if they suggest or make optional but do not require steps to be performed or limit a claim to particular structure" (Advisory Action, page 2). On that basis, the Examiner declines to give patentable weight to the subject "wherein" limitations.

Applicants note that the limitations in question include the limitations that Applicants have argued distinguish the present invention from the cited art (see, e.g., amendment filed on 9/30/05, pp. 12-16). Applicants also note that the Examiner raises this issue for the first time in the Advisory Action. To obviate further debate on this issue and to expedite prosecution, however, Applicants have amended the independent claims to remove the term "wherein" from the independent claims. Nonetheless, Applicants respectfully submit that the Examiner misinterprets the law in this regard.

First, MPEP 2111.04 states that "wherein" clauses may raise a question as to the limiting effect of the claim language, not that they necessarily do so in all cases. In the present application, there is and was nothing "optional" about the claim limitations in

question. General guidelines set forth in MPEP sections should not be applied blindly, without regard to the particular claim language in question.

Secondly, case law makes clear (as cited in MPEP 2111.04) that when a "wherein" clause or the like "states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ.2d. 1481, 1483 (Fed. Cir. 2005)(emphasis added). In the present case, the limitations in question ("wherein" clauses) include the limitations that Applicants have argued distinguish the present invention from the cited art (see amendment filed on 9/30/05, pp. 12-16). Hence, the limitations in question are clearly material to patentability. Therefore, it is improper for the Examiner not to give those limitations patentable weight. The Examiner is therefore respectfully requested to reconsider Applicants' previously submitted arguments regarding those limitations.

Further, regarding the statement in the Advisory Action that "it would be inherent that there would be multiple wireless subscribers and thus multiple domains," (Advisory Action, page 3), Applicants respectfully submit that it would not be inherent, on the basis of there being multiple wireless subscribers, to have multiple domains which have the specific characteristics recited in Applicants' claims (as previously discussed, pp. 12-16 of amendment filed on 9/30/05). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original and added). The Examiner has not done so in this case.

The Advisory Action also states, "In addition, the Billing Model Figure and the Commission Manager suggest that InfiniteMAP system would store data related to a billing relationship between multiple wireless subscribers and application providers as for example, claim 1 recites, if the 'wherein clauses' were to be given patentable weight" (Advisory Action, page 3). Even assuming *arguendo* that assertion were true, that still would not equate to or suggest the specific claim limitation that each of the domains further represents a billing relationship between a business entity and the corresponding subset, of multiple subsets, of the plurality of wireless services subscribers, as recited in claim 1 for example, much less where each "domain" also has all of the other characteristics recited in the claim.

Applicants, therefore, respectfully maintain all of their previously submitted arguments regarding the prior art rejections (pp. 3-7 of response filed on 2/21/2006, and pp. 12-16 of amendment filed on 9/30/05), all of which are incorporated by reference into this response. For those reasons, Ellipsus does not anticipate the present invention or render it obvious.

Request for Telephone Interview

Applicants respectfully request a telephone interview with the Examiner, prior to the Examiner's acting on this response, if the Examiner does not find the present application to be allowable after considering this response. In that event, the Examiner is requested to call Applicants' representative (the undersigned) at telephone number (408) 720-8300 to schedule such an interview.

Conclusion


For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Jordan M. Becker
Reg. No. 39,602

Customer No. 26529
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(408) 720-8300